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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,472	07/09/2001	Peter K. Kassab	3404 P 005	6545
7590	05/03/2005		EXAMINER	
WALLENSTEIN & WAGNER, LTD. 311 South Wacker Drive, 53rd Floor Chicago, IL 60606-6630			MAKI, STEVEN D	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/901,472	KASSAB, PETER K.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Steven D. Maki	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 2-7-05 and 10-26-04.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,2,4-6,11,13,14,16 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 16 is/are allowed.
- 6) Claim(s) 1,2,4-6,11,13,14 and 22-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>042805</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.  |

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- 1) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 23, it is unclear if an intermediary or a sticker assembly (intermediary adhered to window sticker) is being claimed. The preamble appears to suggest that the intermediary is being claimed whereas the language regarding trimming suggests that the sticker assembly is being claimed. If the sticker is not being claimed then the meets and bounds of claim 23 is ambiguous since the "trimming limitation" depends on unclaimed subject matter (the sticker). In other words, "are trimmed" is meaningless if the intermediary being trimmed is not associated with the sticker.

- 3) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Langen

- 4) **Claims 1, 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langen in view of Honaker (US 4935288) or Yoshida et al.**

Langen, Honaker and Yoshida et al are applied as in paragraph 8 of the last office action (paragraph 8 of the last office action is incorporated herein by reference).

Applicant's argument that there is no motivation to combine Langen with Honaker or Yoshida is not persuasive because (1) Langen discloses using label stock for the two strips and (2) the use of vinyl for label stock is suggested by Honaker or Yoshida et al. No unexpected results for using "vinyl" for the two strips has been shown.

Applicant argues that the structure of claim 1 is distinguishable from Langen since claim 1 has a trimmed edge and the strip of Langen does not. This argument is not persuasive since the edges of Langen's strips are in registry with the edges of the sticker after slitting and bursting. See MPEP 2113.

Applicant argues that there is no need for another trimming operation in Langen. This argument is off point. The article claims fail to require a trimming operation.

With respect to the first protective layer and the second protective layer (claim 14), Langen teaches this subject matter. See release strips 37.

German 696

5) **Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 (DE 29720696) in view of Japan '014 (JP 9-97014) and further in view of at least one of Great Britain '233 (GB 2174233) and Langen (US 5290067).**

German 696, Japan 014, Great Britain 233 and Langen are discussed in paragraph 6 of the last office action (paragraph 6 of the last office action is incorporated herein by reference). German 696 does not specifically recite "vinyl".

As to claim 23, it would have been obvious to one of ordinary skill in the art to use vinyl for the transparent film of German '696 such that the foil is optically clear since

(1) German 696 teaches that the foil is transparent and (2) vinyl is a known transparent resin to one of ordinary skill in the sticker art as evidenced for example by Japan '014.

Furthermore, it would have been obvious to one of ordinary skill in the art to provide a protective layer on the "low tack" adhesive of German 696's mounting aid since it is well known / conventional to cover adhesive with a protective layer (release liner / backing sheet), which protects the adhesive prior to removal therefrom as evidenced by at least one of Great Britain 233 (page 1) and Langen (col. 5).

German 696's mounting aid has edges. The trimming language relates to intended use and fails to require edges different from the edges of the foil disclosed by German 696.

The above rejection constitutes a *prima facie* case of obviousness. No further modification of German 696 is required by claim 23.

As to the "low tack adhesive layer": The claimed low tack adhesive layer reads on German '696's adhesive layer having the lower adhesive strength / lower adhesive force. In any event: The limitation of the adhesive layer being low tack so as to permit releasable adherence / peeling without damage would have been obvious to one of ordinary skill in the art in view of (a) German '696's teaching that the adhesive force of the adhesive layer is lower than the adhesive force of the adhesive coating on the sticker so that the adhesive assembly may be easily removed from the window and optionally (b) Great Britain '233's teaching to use an adhesive having a "lesser degree of adhesion" so a sticker assembly can be removed from a window and/or Langen's teaching to use a repositionable adhesive, such as that manufactured by 3M for Post-

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It® notes, for a sticker for a window so that the sticker may be removed from the window without leaving adhesive residue on the window. In Great Britain '233 (directed to a sticker assembly for a window), the adhesive for fixedly attaching is between a first side of transparent film 10 and an indicia bearing film 13 and the adhesive permitting removal of the sticker assembly from the window is on a second side of the transparent film 10 (see figure 9 of Great Britain '233). In Langen (directed to a sticker assembly for a window), the adhesive for fixedly attaching (the permanent adhesive 35) is between a first side of label stock 34 and label 12 and the adhesive for permitting removal of the sticker assembly from the window (the repositional adhesive 36) is on a second side of the label stock 34 (see figure 3 of Langen).

As to the indicia bearing surface being viewable through a window, one of ordinary skill in the art would readily understand that the sticker of German '696 has indicia viewable through a receiving surface since the sticker assembly of German '696 is for a car window. In other words, one of ordinary skill in the art would readily appreciate that the film is transparent in German '233 so that the sticker - including any indicia thereon- can be viewed through the transparent film and the window. In any event: It would have been obvious to one of ordinary skill in the art to provide the sticker of German '696's sticker assembly with an indicia bearing surface such that it can be viewed through a window in view of the admitted prior art's suggestion to view indicia of a sticker through the vehicle window and /or Great Britain '233's suggestion to view indicia (e.g. wording on item 13) of a sticker assembly through both the transparent film 10 of the sticker assembly and a vehicle window.

As to continuous, uninterrupted: German '696's transparent film is considered to be non-perforated, continuous and uninterrupted. In any event: It would have been obvious to provide German '696's transparent film as a continuous, uninterrupted transparent film since German '696, which fails to teach forming holes, teaches using the transparent film as a mounting aid for a sticker.

6) **Claims 1, 2, 4, 5, 6, 11, 13, 14 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 (DE 29720696) in view of Courtney (US 5622389) and Japan '014 (JP 9-97014) and optionally further in view of at least one the admitted prior art (specification pages 1-3, page 18 lines 12-17), Great Britain '233 (GB 2174233) and Langen (US 5290067).**

German 696, Courtney, Japan 014, the admitted prior art, Great Britain 233 and Langen are applied as in paragraph 6 of the last office action (paragraph 6 of the last office action is incorporated herein by reference).

Applicant argues that the applied prior art does not teach trimming the vinyl film so that the edges of the film are in registry with the edges of the sticker. This argument is not persuasive.

First: **German 696 and Courtney both disclose adhering a sticker to a transparent plastic sheet of a removable mounting aid using adhesive of the sticker and detachably mounting this sticker assembly to a surface of a vehicle.** Courtney also teaches matching the shape of the mounting aid to the shape of the sticker by **trimming** the mounting aid to place the edges of the mounting aid in registry with the sticker so that the device becomes virtually undetectable to the casual viewer.

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Courtney motivates one of ordinary skill in the art to trim German 696's mounting aid so that the mounting aid is undetectable and the potential for theft is reduced by the appearance of permanent fixation; applicant having presented no convincing argument and/or evidence to the contrary. In short, **the motivation** for combining German 696 and Courtney is making a mounting aid undetectable to the casual viewer and reducing the potential for theft by the appearance of permanent fixation. See col. 1 lines 44-47, col. 1 lines 58-62 and col. 2 lines 47-57 of Courtney.

Second: With respect to "film", German 696 teaches this subject matter because German 696's mounting aid comprises a "transparent foil" (a "transparent film"). See page 3 of translation for German 696. German 696 also teaches a "low tack adhesive layer" as claimed since the "adhesive strength of the adhesive layer is markedly less than the adhesive strength of the actual sticker". See page 3 of translation for German 696.

Third: With respect to vinyl, Japan 014 provides ample suggestion to use polyvinyl chloride as the material for German 696's transparent foil since Japan 014 suggests using polyvinyl chloride as the material for a transparent sheet. No unexpected results for using a composition comprising "vinyl" for the claimed film has been shown.

Applicant identifies several advantages of the present invention including using trimming to make the film virtually undetectable to help avoid theft of the sticker assembly. These comments are not persuasive of non-obviousness since using trimming to make the film virtually undetectable to help avoid theft of the sticker

assembly is not an unexpected result. See Courtney's teaching to use trimming to make a mounting aid undetectable and thereby reduce potential for theft.

With respect to applicant's comment that Courtney uses Velcro strips, Examiner comments that Courtney suggests using "adhesive materials" such as "double-sided tape". See col. 2 lines 24-27.

Applicant comments that Courtney discloses mounting a bumper sticker on a mounting aid. The examiner agrees that Courtney, like German 696, teaches adhering a mounting aid to a sticker. The examiner adds that Courtney teaches that the sticker may be mounted on surfaces other than a bumper. See col. 2 lines 30-31. Applicant argues that there is no suggestion to combine German 696 and Courtney. The examiner disagrees. German 696 and Courtney share the common subject matter of adhering a sticker on a mounting aid comprising a transparent plastic sheet and temporarily mounting the resulting assembly to a surface of a vehicle. Courtney suggests trimming German 696's mounting aid so that the mounting aid for the sticker is virtually undetectable to the casual observer. This benefit disclosed by Courtney is applicable to German 696 since the sticker assembly of both German 696 and Courtney are applied to a surface of a vehicle.

Applicant asserts that German 696 teaches a one size fits all product and that "... the film must be at least slightly larger than the largest stickers to assure operability. The film cannot be undersized or else the high-tack adhesive on the sticker will extend past the film and be able to contact the receiving surface, thus rendering the film inoperable for its stated purpose". See page 12 of response filed 10-26-04. The

examiner agrees with applicant that the German 696 teaches that the film of the mounting aid *may* be larger than sticker. This conclusion is supported by evidence including the translation of German 696 and paragraph 7 of Kassab's declaration filed 10-26-04. However, nothing in the translation of German 696 teaches that the mounting aid *must always remain* larger than the sticker. Moreover, Courtney suggests trimming a mounting aid, which is larger than the sticker so that the mounting aid is virtually undetectable to the casual observer. One of ordinary skill in the art is apprised from Courtney of the problem (theft potential) of a mounting aid being larger than the sticker and is instructed of the solution (trimming the mounting aid).

Applicant asserts that trimming is not readily known. This argument is not commensurate in scope with the article claims since the article claims require edges in registry instead of a step of trimming. With respect to a step of trimming, this argument is not persuasive for the simple reason that a step of trimming a mounting aid is disclosed by the prior art (i.e. US Patent 5622389 to Courtney).

Applicant argues that German 696 teaches away from the film having a size and shape matching that of the adhesive on the sticker. The examiner disagrees. German teaches "using the film as a releasable mounting aid for a sticker". The mounting aid is used (i.e. the function of the mounting aid is) to cover the adhesive on the sticker. The mounting aid therefore has a shape and size at least that of the adhesive coating of the sticker.

As to the protective layer in claims 6 and 11, it would have been obvious to one of ordinary skill in the art to provide a protective layer on the "low tack" adhesive of

German 696's mounting aid since it is well known / conventional to cover adhesive with a protective layer (release liner / backing sheet), which protects the adhesive prior to removal therefrom as evidenced by at least one of Great Britain 233 (page 1) and Langen (col. 5). Furthermore, it would have been obvious to place the edges of protective layer in registry with the edges of the film and the edges of the sticker in view of (1) the above noted suggestion from at least one of Great Britain and Langen to cover the "low tack" adhesive of German 696's mounting aid with a protective sheet and (2) Courtney's teaching to trim edges of a mounting aid so that the mounting aid matches the shape of the sticker.

As to the protective layer in claim 14, it would have been obvious to provide the German 696's mounting aid with two protective layers as claimed in view of Langen's suggestion to cover first and second strips of repositionable adhesive with first and second strips of protective layers (release liners), which protect the adhesive strips prior to removal therefrom. Furthermore, it would have been obvious to place the edges of the first and second protective layers in registry with the edges of the films and the edges of the sticker in view of (1) the above noted suggestion from Langen to cover first and second strips of adhesive with first and second strips of protective layers (release liners), which protect the adhesive strips prior to removal therefrom and (2) Courtney's teaching to trim edges of a mounting aid so that the mounting aid matches the shape of the sticker.

As to claim 23, note both the comments on claim 6 set forth in this office action and in set forth in paragraph 6 of the last office action. Claim 23 does not exclude the sticker.

As to claim 24, note comments on claim 1 set forth in paragraph 6 of the last office action. With respect to the word "strip", it would have been obvious to use German 696's mounting aid for a sticker in strip form since both German 696 and Courtney suggest using a mounting aid for a sticker and Courtney suggests provide in the sticker in the form of a strip. Claim 24 fails to exclude a vinyl strip covering the entire surface of the sticker. Claim 24 fails to require a second strip. With respect to "undetectable", note Courtney's teaching to trim so that the mounting aid is virtually undetectable to the casual observer. With respect to the adhesive layer having a strength such that the film cannot be separated from the adhesive without destroying the film and the sticker, note German '696 and optionally the admitted prior art's teaching to use a relatively strong adhesive for the sticker.

Alternatively: As to claim 24, note comments on claim 22 set forth in paragraph 6 of the last office action. With respect to "undetectable", note Courtney's teaching to trim so that the mounting aid is virtually undetectable to the casual observer. Claim 24 fails to exclude the second strips.

Applicant's arguments regarding the use of two strips instead of one strip are not persuasive since German 696 and Langen fairly suggest obtaining temporary adhesion for the admitted prior art's sticker which has two strips of adhesive by applying two strip mounting aids (each comprising a strip coated with lower strength adhesive) on the two

strips of adhesive of the admitted prior art sticker. With respect to the edges being in registry, Langen teaches this subject matter (see figure 2) and Courtney provides strong motivation to place edges in registry to make the mounting aid virtually undetectable to the causal observer / reduce potential for theft. As to the method step of trimming, Courtney teaches this subject matter. See col. 2.

**7) Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over German '696 in view of Courtney and Japan '014 and optionally further in view of at least one the admitted prior art, Great Britain '233 and Langen as applied above and further in view of Yoshida et al (US 4670490).**

Yoshida et al is applied as in paragraph 7 of the last office action (paragraph 7 of the last office action is incorporated herein by reference).

#### **Allowable Subject Matter**

**8) Claim 16 is allowed.**

The terminal disclaimer filed 3-1-04 is proper and has been recorded. Accordingly, the obvious type double patenting rejection over US 6258200 has been withdrawn.

Although the use of spaced strips of adhesive is known per se as shown by Langen (US 5290067) and Travis (US4536423), there is no motivation to modify the static cling sticker assembly of Great Britain '256 so as to include the step of placing strips of static-cling film coinciding with the strips of adhesive; it being noted that (a) Great Britain '256, which does not disclose using strips of static-cling film, teaches covering the entire surface of the vehicle window sticker (printed sheet) with the static

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cling film and (b) Great Britain '551, which also does not disclose using strips of static cling material, teaches using a single static cling sheet (instead of the claimed strips of static cling film) to define an edge margin of static cling material for a vehicle windshield sticker.

Remarks

9) Applicant's arguments filed 10-26-04 have been fully considered but they are not persuasive. Applicant's arguments are addressed above.

With respect to "protective layer" (claims 6, 11, 14 and 23), note the new ground of rejection in which at least one of Great Britain 233 and Langen is relied upon for this newly claimed subject matter.

Applicant argues that the reasons for allowance for claim 16 equally apply to claim 13. The examiner disagrees since claim 16 requires strips of static cling film whereas claim 13 requires low tack adhesive.

The declaration under 37 CFR 1.132 filed 10-26-04 is insufficient to overcome the rejection of claims 1, 2, 4-6, 11, 13, 14 and 22-24 as set forth above in this Office action because:

(1) The solution ("intermediary layer including low tack adhesive") to the problem of difficult to remove stickers is found in the prior art. See German 696 and Langen.

(2) Courtney teaches trimming a transparent sheet of a mounting aid to make the mounting aid virtually undetectable - US Patent 5622389 is evidence showing that trimming is known concept in the field of stickers.

(3) The relationship between "My product" and the claimed invention is not clear.

(4) It appears that the evidence in the declaration is not commensurate in scope with the claims since sales of the product appear to be for the untrimmed sticker assembly instead of the trimmed sticker assembly of claim 1.

(5) The evidence of obviousness (e.g. German 696's teaching to use a window sticker mounting aid to facilitate detachment of sticker from a window and Courtney's teaching to trim a mounting aid to make the mounting aid virtually undetectable to the casual observer) outweighs the evidence for non-obviousness (e.g. Kassab's 132 declaration).

- 10) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki  
May 1, 2005

  
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